

REMARKS

Claims 49-68 were presented for examination, and were rejected over Burdon, et al., U.S. Patent No. 6,572,830. Burdon was cited under 35 U.S.C. § 102(e). No other references were cited against the claims.

Burdon is a patent that matured from an application that was filed on June 21, 1999, as a CIP of an earlier application. The earlier application was allowed as U.S. Patent No. 6,592,696. The '696 patent and the Burdon reference both claim priority to a provisional application filed on October 9, 1998.

The provisional application appears to largely correspond to the '696 patent. The '696 patent relates to a method for "fabricating a multilayer structure out of sheets of green-tape..."; a search of the text of the '696 patent (using the text version in PAIR) showed that it mentions in column 4, lines 40-41, that 'magnetic materials' may be included in the structure; however, that appears to be its only discussion of magnets or magnetic materials. The '696 patent does not discuss a chip comprising microelectromagnetic units, or methods for using such microelectromagnetic units to manipulate magnetic particles in or on a chip. In addition, the '696 patent claims methods to "fabricate a substantially monolithic device," but it does not claim any method such as the ones presently claimed. Thus the '696 patent and its priority document are not believed to support any of the disclosures on which the Examiner relied when rejecting the present claims. None of the disclosures in Burdon that were alleged to be relevant to the present claims is entitled to a priority date based on the provisional application, 60/103,701, filed in 1998, or on the earlier utility application, serial no. 09/235,081, filed on January 21, 1999. Therefore, the earliest priority date available for the relevant portions of the Burdon reference is the filing date of Burdon's patent application, serial no. 09/337,086, which was filed on June 21, 1999.

The present application claims priority to a Chinese patent application filed March 15, 1999, which thus predates the allegedly relevant portions of the Burdon reference. A certified copy of the priority document for the Chinese patent application was provided with the parent application for this one, which is serial no. 09/399,299, and the claim of priority to that application is

acknowledged on the Filing Receipt for this application. Therefore, the application is entitled to claim priority to the Chinese application, which predates the cited reference.

A translation of the Chinese priority document is provided with this response as **Exhibit B**. The accuracy of the translation of the priority document is verified by a statement from one of the inventors, who is knowledgeable of both English and Chinese, and understands the invention; that verification statement is attached as **Exhibit A**.

The claims are supported by the priority document, which discloses at least one embodiment of a device having electromagnetic units. See, e.g., claim 1 and the first paragraph of the priority document. The priority document also describes methods for using such devices for the directed manipulation of magnetically modified ligand molecules or particles. See, e.g., claim 24 and the opening paragraph of the priority document. Because the present claims are entitled to a priority date that is earlier than the priority date available for the portions of Burdon that were cited by the Examiner, Burdon is not prior art to the instant claims. Accordingly Burdon does not anticipate the claims under 35 U.S.C. 102(e), and this rejection should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 471842001411. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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